

JFW



Docket No. 2024728-7039313001
(04-0004US4)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:)
)
Brian D. Zelickson, et al.)
)
Serial No. 10/633,820)
)
Filed: August 4, 2003)
)
For: **DEVICE AND METHOD FOR**)
TREATMENT OF GASTROESOPHAGEAL)
REFLUX DISEASE)

TRANSMITTAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is an executed Prosecution by Assignee, Revocation of Prior Powers, and Appointment of New Power of Attorney Under 37 CFR § 3.71 and Courtesy copy of assignments and cover sheets submitted to the Patent Office on June 24, 2004 (10 pages) for the above-identified application.

Respectfully submitted,

BINGHAM McCUTCHEN LLP

Dated: June 24, 2004

By: 

Scott S. Kokka
Reg. No. 51,893

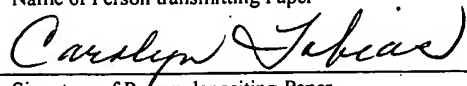
BINGHAM McCUTCHEN LLP
Three Embarcadero, Suite 1800
San Francisco, CA 94111-4067
(650) 849-4400

CERTIFICATE OF MAILING (37 C.F.R. §1.8)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposit with the United States Postal Services on the date shown below with sufficient postage as "First Class Mail" to addressee in an envelope addressed to the Commissioner for Patents, Alexandria, VA 22313-1450

6/24/04
Date of deposit

Carolyn Tobias
Name of Person transmitting Paper


Signature of Person depositing Paper



04-0004054

PATENT
Docket No. 2024728-7039313001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Brian D. Zelickson, et al

Serial No.: 10/633,820

Filed: August 4, 2003

**For: DEVICE AND METHOD FOR
TREATMENT OF
GASTROESOPHAGEAL REFLUX
DISEASE**

Group Art Unit: 3736

Examiner: Not Yet Assigned

**PROSECUTION BY ASSIGNEE, REVOCATION OF PRIOR POWERS, AND
APPOINTMENT OF NEW POWER OF ATTORNEY
UNDER 37 C.F.R. § 3.71**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

SCIMED Life Systems, Inc., a Minnesota Corporation, the assignee of the entire right, title and interest in this patent application, under 37 C.F.R. § 3.71 hereby appoints all attorneys associated with:

Customer Number 23639

with full powers of substitution and revocation, to prosecute this application and transact all matters in the United States Patent and Trademark Office, and in countries other than the United States, and to do all things necessary or appropriate therefore before any competent International Authorities in connection with any international patent application(s) corresponding to the above-identified application, said appointment to be to the exclusion of the inventors and their attorneys in accordance with the provisions of 37 C.F.R. § 3.71.

Please direct all written communications relative to this application to:

David T. Burse
Bingham McCutchen LLP
Three Embarcadero Center, Suite 1800
San Francisco, CA 94111-4067

Please direct all telephone communications to David T. Burse at (650) 849-4400

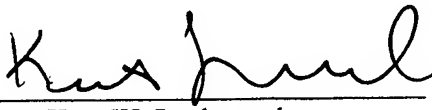
I, the undersigned, declare that I have reviewed copies of the documentary evidence establishing chain of title to the patent application identified above from the inventor(s) to the assignee(s), which:

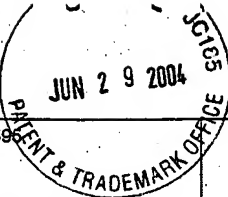
- ☒ is filed for recordation herewith; or
☐ was recorded at Reel _____, Frame _____; or
☐ has been sent for recordation under separate cover, copy attached herewith.

To the best of the undersigned's knowledge and belief, title is in the assignee(s) identified above. Furthermore, the undersigned is empowered to sign this document on behalf of the assignee(s).

SCIMED Life Systems, Inc.

Dated: 6/21/04

By: 
Name: Kurt W. Lockwood
Title: Assistant Secretary
Address: One SCIMED Place,
Maple Grove, Minnesota 55311-1566

**RECORDATION FORM COVER SHEET
PATENTS ONLY**U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Docket No. 2024728-7039313001

To the Honorable Commissioner of Patents and Trademarks. Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):
Brian Zelickson and Robert Ganz
Additional name(s) of conveying party(ies) attached?
☐ Yes ☒ No

2. Name and address of receiving party:
Name: BOSTON SCIENTIFIC CORPORATION

Internal Address: One Boston Scientific Place

3. Nature of conveyance:
☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name

City: Natick State: MA Zip: 01760-1537

Street Address: _____

City: _____ State: _____ Zip: _____

Execution Date: December 7, 2003Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is: _____

A. Patent Application No(s): US Patent Application No. 10/633,820B. Patent No(s): US Patent No. 6,073,052; US Patent No. 6,321,121; US Patent No. 6,604,004Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:
Name: David T. Burse

Internal Address: BINGHAM McCUTCHEN LLP
Three Embarcadero, Ste 800
San Francisco, CA 94111-4067

6. Total number of applications and patents involved: 4

7. Total fee (37 CFR 3.41): \$ 40.00
☐ Enclosed

☒ Charge Deposit Account 50-25188. Deposit Account Number: 50-2518**DO NOT USE THIS SPACE**

9. Statement and signature:

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Scott S. Kokka, Reg. No. 51,893

Date: June 24, 2004Total number of pages including cover sheet: 3

OMB No. 0651-0011 (exp. 4/94)

Do not detach this portion

Mail documents to be recorded with required cover sheet information to:

Commissioner of Patents and Trademarks**Box Assignments****Washington, D.C. 20231**

Public burden reporting for this sample cover sheet is estimated to average about 30 minutes per document to be recorded, including time for reviewing the document and gathering the data needed, and completing and reviewing the sample cover sheet. Send comments regarding this burden estimate to the U.S. Patent and Trademark Office, Office of Information Systems, PK2-1000C, Washington, D.C. 20231, and to the Office of Management and Budget, Paperwork Reduction Project, (0651-0011), Washington, D.C. 20503

ASSIGNMENT AGREEMENT

THIS ASSIGNMENT AGREEMENT (this "Agreement"), effective as of December 4, 2003, is by and between BOSTON SCIENTIFIC CORPORATION, a Delaware corporation having its principal place of business at One Boston Scientific Place, Natick, MA 01760-1537 ("BSC") and both Brian Zelickson of 2764 Drew Avenue South, Minneapolis, MN 55416 and Robert Ganz of 13956 Emerald Ridge, Minnetonka, MN 55305 (collectively "Assignors").

WITNESSETH

WHEREAS, BSC manufactures, markets and sells medical products; and

WHEREAS, Assignors have worked on certain inventions, rights and technical information relating to radiofrequency "RF" ablation devices; and

WHEREAS, BSC wishes to obtain from Assignors and Assignors wish to assign to BSC all of their right, title and interest in and to such inventions, rights and technical information.

NOW THEREFORE, in consideration of the mutual promises and covenants contained herein, and for other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the parties hereto mutually covenant and agree as follows:

1. DEFINITIONS.

(a) "Affiliate" means any corporation or other business entity which, directly or indirectly, controls or is controlled by, or is under common control with a person or entity.

(b) "Assigned Rights" has the meaning set forth in Section 2(a) hereof.

(c) "Improvements" mean all ideas and developments related to any Product (as defined in Section 1(f) hereof), whether patentable or not, the rights to which Assignor owns or controls as of the date hereof, or hereafter acquires by assignment, license or otherwise, or which fall within the scope of any claim of any patent or patent application included within the Patent Rights.

(d) "Inventions" has the meaning set forth in Section 1(e) hereof.

(e) "Patent Rights" mean all rights in and to the inventions set forth in Exhibit A hereto ("Inventions"), as such Exhibit A may be amended from time to time, and all original and provisional patent applications on any Inventions and Improvements, and all original, continuation, divisional, continuation-in-part, or reissue patent applications with respect to any such original or provisional patent applications, all unexpired patents issued on any such patent applications, and all extensions, reexaminations, reissues, renewals or foreign counterparts of any of the foregoing.

(f) "Products" mean the devices described in the Inventions set forth in Exhibit A hereto, products developed that embody the Assigned Rights and products that fall within the scope of any claim of any unexpired patent included in the Patent Rights, or within the scope of the broadest good faith claim (in light of the prior art) in any pending patent application included in the Patent Rights, or that otherwise employ an invention disclosed in a patent or patent application which is included in the Patent Rights.

(g) "Technical Information" means all know-how, data and other information in the possession of or developed or acquired by Assignor that is useful in the evaluation, development, testing, registration, manufacture, use, or sale of any Products.

2. ASSIGNMENT AND GRANT OF RIGHTS.

(a) Assignors hereby wholly assign to BSC all of their existing and future right, title and interest in and to (i) the Patent Rights, including the right to use, manufacture, have manufactured or sell any Products, (ii) all Improvements, and (iii) all Technical Information (the "Assigned Rights"). Without limiting the foregoing, BSC shall have the right to market and advertise the Products under BSC's name, trademarks, tradenames, labels and other designations which shall remain and be the sole property of BSC.

(b) Assignors shall provide at a reasonable charge to BSC all reasonable assistance to BSC and its Affiliates and their representatives in connection with the preparation, prosecution, maintenance and defense of all patents and patent applications fileable with respect to the Patent Rights. Assignors shall also execute all appropriate documents and assignments reasonably requested by BSC with respect to any such patents and patent applications.

3. ASSIGNMENT FEE. In full consideration for Assignors' assignment and grant of rights pursuant to Section 2 hereof, BSC shall pay each Assignor an assignment fee of \$67,500.00 for a total payment of \$135,000.00, payable within 21 days after execution and delivery of this Agreement.

4. TECHNICAL INFORMATION. Assignors shall promptly disclose to BSC all Improvements and Technical Information relating to the Assigned Rights. It is contemplated that Assignors and BSC may, from time to time in the performance of this Agreement, disclose to each other certain confidential information, limited to the field of radio-frequency treatment of sphincters, including Technical Information, and other know-how, techniques and processes, and trade secrets. To the extent it is deemed confidential, all such information, know-how, techniques, processes and trade secrets shall remain proprietary to Assignors and BSC, as the case may be. Assignors and BSC mutually agree to keep such information in confidence to the same degree and with the same protection by which they maintain their own proprietary information confidential, except to the extent such information must reasonably be disclosed in connection with the sale of Products. BSC, subject to the above confidentiality requirements, and to the extent such information relates to the Assigned Rights, may use such information at no cost for all time for any purpose in the furtherance of the intent of this Agreement. For purposes of this Agreement, information shall not be deemed confidential if (i) the receiving party can show that, at the time of disclosure or thereafter, the information is available in the public domain by publication or otherwise; or (ii) the receiving party can show, by its written records, that the information was already in its possession at the time of disclosure by the other party; or (iii) the receiving party can show that such information was independently developed without access to such information; or (iv) the receiving party acquired the information from a third party who had the legal right to disclose it. The termination of this Agreement shall not relieve Assignors or BSC from the obligation of maintaining the confidentiality of such information for a period of 1 year following termination.

5. COVENANTS, REPRESENTATIONS AND WARRANTIES OF THE ASSIGNOR.

Assignors covenant, represent and warrant, jointly and severally:

(a) That, to the best of Assignors' knowledge and belief, (i) Assignors jointly own all right, title, and interest in and to the Assigned Rights, free of any liens or encumbrances, and (ii) that the Assigned Rights do not infringe any third party's patent rights;

(b) That there is no person, firm, or corporation (other than BSC or the other Assignor) claiming to have, through Assignors, any title or interest in or to any of the Assigned Rights;

(c) Except with respect to agreements between Assignors and BSC, that there are currently no outstanding options, licenses or agreements of any kind relating to the Assigned Rights, or to any know-how, trade secrets, techniques, processes, or other confidential information relating thereto, nor, to the best knowledge of Assignors, are there any outstanding claims of any kind relating to any of the foregoing; and further, that Assignors will not grant any such options, licenses, or agreements to any third party;

(d) That Assignors have full power to assign the Assigned Rights to BSC, to grant the rights and privileges herein given and to enter into this Agreement;

(e) That Assignors have not caused and will not cause, through Assignors' actions or omissions to act, all or any part of the Patent Rights to be considered or rendered abandoned, invalid or unenforceable; and

(f) That Assignors shall perform all legally proper acts and execute all documents as are reasonably needed for carrying out the intent of this Agreement.

6. PATENT APPLICATIONS AND FOREIGN FILING. BSC shall have the right, but not the obligation, to file, prosecute, and maintain in force any and all patents and applications for patents, worldwide and within the United States, falling within the Patent Rights.

7. THIRD PARTY INFRINGEMENT. In the event any of the Patent Rights shall be infringed, BSC may, but shall not be obligated to, institute and prosecute, at its own expense, any action in the name or names of the inventors listed on the patents and applications included in the Patent Rights to protect its rights under this Agreement. In any such action, Assignors shall fully cooperate with BSC, at a reasonable reimbursement for their time and reasonable expenses.

8. ASSIGNMENT. This Agreement shall be binding upon and inure to the benefit of the parties hereto and their respective successors and permitted assigns.

9. MISCELLANEOUS:

(a) This Agreement shall be deemed to have been made and shall be construed under the laws of The Commonwealth of Massachusetts, United States of America, without regard to the conflicts of laws provisions thereof. This Agreement shall not be construed as creating the relationship of master and servant, principal and agent, or a co-partnership or joint venture between the parties. The rights and privileges granted hereunder to BSC shall inure to the benefit of BSC and its Affiliates.

(b) This Agreement supersedes any prior understanding concerning this subject matter and contains the entire Agreement between the parties respecting the subject matter covered hereby. No modification or waiver of any portion of this Agreement shall be made without the written consent of all parties hereto unless such portion is in violation of any laws. All of the provisions in this Agreement will be considered as separate terms and conditions, and in the event that any one is held to be illegal, invalid or unenforceable, that provision shall be interpreted to the maximum extent enforceable, and the other provisions hereof shall remain in full force and effect. The section headings contained in this Agreement are for reference purposes only and shall not affect in any way the meaning or interpretation of this Agreement. Whenever the words "include", "includes" or "including" are used in this Agreement, they shall be deemed in each instance to be followed by the words "without limitation."

(c) Any notice required to be given hereunder shall be given by registered mail, return receipt requested, postage prepaid or by guaranteed overnight delivery through a nationally recognized courier that guarantees overnight delivery, and if intended for the Assignors shall be addressed to Assignors at the addresses set forth above, or if intended for BSC, addressed to Boston Scientific Corporation, One Boston Scientific Place, Natick, Massachusetts, 01760, Attn: General Counsel, or at such other address as the parties hereto shall designate by notice given as herein provided. The notice given, as aforesaid, shall be deemed to be received by the party to whom it is addressed within the time which would ordinarily be required for the receipt of registered or overnight mail, as the case may be.

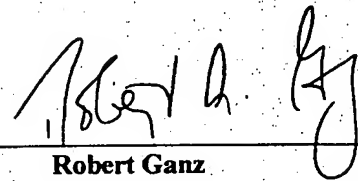
(d) This Agreement may be executed and delivered in one or more counterparts, each of which when executed and delivered shall be deemed to be an original, but all of which when taken together shall constitute one and the same Agreement.

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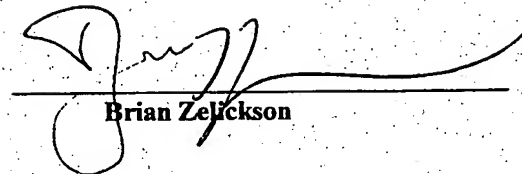
IN WITNESS WHEREOF, the parties have caused this Agreement to be executed under seal as of the date first written above.

BOSTON SCIENTIFIC CORPORATION

By: _____
Name: _____
Title: _____

 12/7/03

Robert Ganz



Brian Zelickson

EXHIBIT A

INVENTIONS

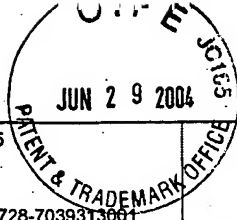
US Patent No. 6,073,052

US Patent No. 6,321,121

US Patent No. 6,604,004

US Patent Application No. 10/633,820

Related foreign applications



FORM PTO-1595
1-31-92

RECORDATION FORM COVER SHEET PATENTS ONLY

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Docket No. 2024728-7039313601

To the Honorable Commissioner of Patents and Trademarks. Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):
Boston Scientific Corporation
Additional name(s) of conveying party(ies) attached?
☐ Yes ☒ No

2. Name and address of receiving party:
Name: SCIMED Life Systems, Inc.

Internal Address: One Scimed Place

3. Nature of conveyance:
☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Other _____

City: Maple Grove State: MN Zip: 55311-1566

Street Address: _____

City: _____ State: _____ Zip: _____

Execution Date: June 21, 2004

Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is: _____

A. Patent Application No(s): US Patent Application No. 10/633,820

B. Patent No(s): US Patent No. 6,073,052; US Patent No. 6,321,121; US Patent No. 6,604,004

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:
Name: David T. Burse

Internal Address: BINGHAM McCUTCHEN LLP
Three Embarcadero, Ste 800
San Francisco, CA 94111-4067

6. Total number of applications and patents involved: 4

7. Total fee (37 CFR 3.41): \$ 40.00
☐ Enclosed

☒ Charge Deposit Account 50-2518

8. Deposit Account Number: 50-2518

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9. Statement and signature:

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Date: June 24, 2004

Scott S. Kokka, Reg. No. 51,893

Total number of pages including cover sheet: 3

OMB No. 0651-0011 (exp. 4/94)

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Washington, D.C. 20231

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ASSIGNMENT OF PATENT APPLICATION

WHEREAS, **Boston Scientific Corporation**, a Delaware Corporation having its principal place of business at One Boston Scientific Place, Natick, Massachusetts 01760-1537 (hereinafter referred to as "ASSIGNOR"), own all rights, titles and inventions in U.S. Patent No. **6,073,052** issued on June 6, 2000 and entitled **DEVICE AND METHOD FOR TREATMENT OF GASTROESOPHAGEAL REFLUX DISEASE**, U.S. Patent No. **6,321,121** issued on November 20, 2001 and entitled **DEVICE AND METHOD FOR TREATMENT OF GASTROESOPHAGEAL REFLUX DISEASE**, U.S. Patent No. **6,604,004** issued on August 5, 2003 and entitled **DEVICE AND METHOD FOR TREATMENT OF GASTROESOPHAGEAL REFLUX DISEASE**, and U.S. Patent Application No. **10/633,820** filed on August 4, 2003 and entitled **DEVICE AND METHOD FOR TREATMENT OF GASTROESOPHAGEAL REFLUX DISEASE** by virtue of assignment of same from the inventors on December 4, 2003; and

WHEREAS, **Scimed Life Systems, Inc.**, a corporation organized and existing under and by virtue of the laws of the state of Minnesota and having its principal place of business at One Scimed Place, Maple Grove, MN 55311-1566 (hereinafter referred to as "ASSIGNEE"), is desirous of acquiring the exclusive rights, titles and interests in, to and under said inventions and in, to and under any Patents or similar legal protection to be obtained therefor in the United States of America, its territorial possessions and in any and all countries foreign thereto.

NOW, THEREFORE, for good and valuable consideration, the receipt of which is hereby acknowledged, ASSIGNOR hereby sell, assign, transfer and set over unto the said ASSIGNEE, its successors and assigns, the full and exclusive rights, titles and interests to said inventions and to all Letters Patent or application or similar legal protection, not only in the United States and its territorial possessions, but in all countries foreign thereto to be obtained for said inventions by said

application, and to any continuation, division, renewal, substitute or reissue thereof or any legal equivalent thereof in the United States or a foreign country for the full term or terms for which the same may be granted, including all priority rights under the International Convention; and ASSIGNOR hereby authorize and request the United States Commissioner of Patents and Trademarks, and any officials of foreign countries whose duty it is to issue patents or any legal equivalent thereof, to issue said patents to ASSIGNEE, its successors and assigns, in accordance with this Assignment.

ASSIGNOR hereby covenant that no assignment, sale, agreement or encumbrance has been or will be made or entered into which would conflict with this Agreement;

ASSIGNOR further covenant that ASSIGNEE will, upon its request, be provided promptly with all pertinent facts and documents relating to said application, said inventions and said Letters Patent and legal equivalents as may be known and accessible to ASSIGNOR and will testify as to the same in any interference or litigation related thereto and will promptly execute and deliver to ASSIGNEE or its legal representative any and all papers, instruments or affidavits required to apply for, obtain, maintain, issue and enforce said application, said inventions and said Letters Patent and said equivalents in the United States or in any foreign country, which may be necessary or desirable to carry out the purposes thereof.

Boston Scientific Corporation

Dated: 6/21/04

By: 

Name: Kurt W. Lockwood
Title: Senior Patent Counsel